

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Maurice Israel et al.

Group Art Unit: 1647

Application No.: 10/049,296

Examiner: Christopher J. Nichols

Filing Date: August 6, 2002

Confirmation No.: 9468

Title: PROCESS FOR IDENTIFYING MODULATING COMPOUNDS OF NEUROMEDIATORS

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per
Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are _____

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the
☐ \$395.00 (2801) ☐ \$790.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered.
Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted _____

on _____
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least _____,
which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R.
§ 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also
enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	16	MINUS 20 =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims	3	MINUS 3 =	0	x \$88.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$300.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

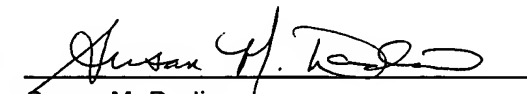
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: October 25, 2004

By


Susan M. Dadio
Registration No. 40,373



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Maurice ISRAËL et al.)	Group Art Unit: 1647
Application No.: 10/049,296)	Examiner: Christopher J. Nichols
Filed: August 6, 2002)	Confirmation No.: 9468
For: PROCESS FOR IDENTIFYING)	
MODULATING COMPOUNDS OF)	
NEUROMEDIATORS)	

REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Office Communication mailed on September 24, 2004 requiring restriction amongst currently pending claims 17-45, applicants hereby elect, with traverse, the invention of Group I, claims 17-26 which as stated in the Office Communication is "drawn to a method of preparing mammalian microcubes of cerebral material and microcubes . . ." OFFICE COMMUNICATION at 2 (emphasis omitted).

Since this application is a national stage filing of a PCT application under 35 U.S.C. § 371, lack of unity standards apply. The Examiner has stated that "[e]ach group has a different technical feature not shared by the remaining groups." OFFICE COMMUNICATION at 3. Applicants respectfully disagree.

Group I contains claims 17-23 which are "drawn to a method of preparing mammalian microcubes of cerebral material" and claims 24-26 which are drawn to a preparation of mammalian "microcubes" obtained by the method of claim 17. OFFICE

COMMUNICATION at 2; *see also* claims 17 and 24. Group II contains claims 27-40 which utilize the "calibrated mammalian microcubes of cerebral material of claim 24". See claim 17. As can be seen from the claims themselves, the claims of Group II depend on the claims from Group I. Thus, the claims of Groups I and II do in fact relate to a single general inventive concept.

Notwithstanding, even if lack of unity or restriction is proper, the Examiner must still establish that there would be an undue burden to examine the groups together in the same application. With regard to at least Groups I and II, no such burden exists since each group involves mammalian microcubes of cerebral material. Thus, a search for one group involving mammalian microcubes of cerebral material would necessarily include the other groups involving mammalian microcubes of cerebral material. Accordingly, the search of the claims of Groups I and II together in the same application would be co-extensive. Because there is no undue burden in examining the claims of Groups I and II together in the same application, the lack of unity/restriction requirement should be withdrawn and/or modified.

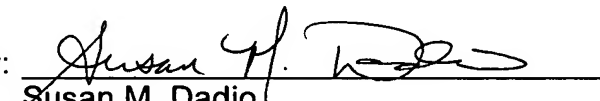
Applicant reserves the right, should the lack of unity/restriction requirement not be withdrawn or modified as requested, to file one or more divisional applications directed to any of the non-elected subject matter

In the event that there are any questions relating to this Amendment and Reply to Restriction Requirement, or the application in general, it would be appreciated if the Examiner would contact the undersigned attorney at concerning such questions so that prosecute of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: October 25, 2004

By: 
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Registration No. 40,373

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